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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,155	12/22/1999	Naiyong Jing	55235USA2A	5837

32692 7590 12/16/2002

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/16/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,155

Applicant(s)

JING, NAIYONG

Examiner

Vivian Chen

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 2, 12-28 have been cancelled.

***Claim Rejections - 35 USC § 103***

5. Claims 1, 3-6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSE ET AL (US 5,227,426) for the reasons stated in paragraph 5 of the previous Office Action.

TSE ET AL disclose a curable adhesive composition comprising an olefin polymer with pendent functional groups such as carboxyl or amide, and catalysts such as tetrabutyl phosphonium bromide, crown ethers, and/or tetrabutyl ammonium hydroxide (columns 12-16, 23-24; lines 5-16, col. 30) as recited in claims 1, 3, 5-6, 10. However, the reference does not explicitly disclose the recited combination of a base and crown ether.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select an effective combination of known catalysts as curing agents and use a commercially available crown ether such as 18-crown-6 ether in the adhesive composition of TSE ET AL depending on the particular functional groups and base polymer used, and the curing properties, adhesive and processing characteristics required by a given application.

6. Claims 1, 3-4, 7, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over KUBILLUS ET AL (US 5,169,979).

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KUBILLUS ET AL discloses a curable polyester composition suitable for adhesives comprising a polyurethane-based or a polyamide-based resin in combination with catalysts such as sodium or potassium hydroxide, crown ethers, and/or tetrabutylammonium fluoride (lines 43-55, 61-64, col. 4; lines 21-53, col. 9) as recited in claims 1, 3, 7, 10. However, the reference does not explicitly disclose the recited combination of a base and crown ether.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select an effective combination of known catalysts as curing agents and use a commercially available crown ether such as 18-crown-6 ether in the adhesive composition of KUBILLUS ET AL depending on the particular functional groups and base polymer used, and the curing properties, adhesive and processing characteristics required by a given application.

#### ***Response to Amendment***

2. The rejection under 35 USC 103(a) based on KRAFT ET AL '192 has been withdrawn in view of Applicant's Amendment filed 2/7/2002

#### ***Response to Arguments***

3. Applicant's arguments filed 2/7/2002 have been fully considered but they are not persuasive.

(A) Applicant argues that TSE ET AL fails to disclose the claimed invention because in the claimed composition, the base and crown ether are incorporated into the polymer. In response to applicant's argument that the reference fails to show certain

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features of applicant's invention, it is noted that the features upon which applicant relies (i.e., base and crown ether being incorporated into the polymer; compositions produced by bulk reaction; etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

TSE ET AL discloses the invention as presently claimed -- namely, a melt-processable, non-fluorinated polymer such as a functionalized polyolefin and a catalyst system containing a base and a crown ether. Applicant has not provided any probative evidence of criticality or unexpected results from the claimed composition or catalyst system which is commensurate in scope with the present claims.

(B) Applicant argues that KUBILLUS ET AL fails to teach the claimed invention because polyester resins have been excluded from the present claims. However, KUBILLUS ET AL clearly discloses the use of other resins such as polyurethane- or polyamide-based compounds (lines 43-55, 61-64, col. 4).

### *Conclusion*

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 12, 2002



Vivian Chen  
Primary Examiner  
Art Unit 1773